Attorney Docket No. 20114/00101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Davis et al.
Serial No.	:	10/811,093
Filed	:	March 26, 2004
For	:	System and Method for Single Point of Entry Deposit
Group Art Unit	:	3694
Confirmation No.	:	9772
Examiner	:	J. Anderson

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated in the attached Pre-Appeal Brief.

The undersigned is an attorney of record and empowered to sign this Request.

Respectfully submitted,

Dated: October 20, 2008

By: _____

Oleg F. Kaplun, Reg. No. 45,559

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

Attorney Docket No. 20114/00101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Davis et al.
Serial No.	:	10/811,093
Filed	:	March 26, 2004
For	:	System and Method for Single Point of Entry Deposit
Group Art Unit	:	3694
Confirmation No.	:	9772
Examiner	:	J. Anderson

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

In support of the Pre-Appeal Brief Request for Review filed herewith, Applicants present a pre-appeal brief in the above-captioned application.

This is a pre-appeal brief regarding the Examiner's final rejection of claims 1- 21 in the Final Office Action dated June 25, 2008.

ARGUMENT

I. The Rejection of Claims 1- 21 Under 35 U.S.C. § 102(b) should be Reversed

Claims 1-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Published Application No. 2007/0029376 to Stoutenburg et al. By asserting that the claims are anticipated, the Examiner in effect is asserting that every limitation is identically taught by Stoutenburg. If Stoutenburg identically teaches every limitation in the claim, then there should be in Stoutenburg a passage that identically teaches "first and second sub-files" into which the "records" have been sorted so that the first sub-file contains "only the non-consumer checks" and that second sub-file contains "only the consumer checks." As noted in the Response Under 37 C.F.R. 1.116, the Examiner cites paragraph [0180] of Stoutenburg to show this feature, yet this paragraph contains no description of such a sorting. The paragraph reads as follows:

> POS device 130 analyzes the payment information to identify a suitable function central control 110 to which the payment is to be directed. POS device 130 contacts the selected function central control 110, transmits the received payment information, and awaits confirmation that the payment has been accepted. Then, in some embodiments, the selected function central control transmits an acceptance of the tendered payment, along with an account balance reflecting the balance after deducting the recently tendered payment. POS device 130 can then print a receipt of the transaction indicating the received payment and/or the new account balance via printer interface 232 or printer interface 256.

According to this paragraph, payment information, which can be entered by the payee as a check that is scanned to an imager 230 (see paragraph [179]), is "directed" to a "suitable function central control 110." According to paragraph [0048], the "function central controls 110 are a money transfer system, a fraud detection system, a phone card system, and a check acceptance system." Figure 1 shows a network topology in which payment information is transferred from POS device 130, through network 120, and to a selected one of function central controls 110a-110. The act of transferring check payment information to one of these function central controls does not involve any sorting of checks in the manner recited in the claim. Moreover, the operation of none of these function central controls involves sorting checks in the manner recited

in the claim. Even the "check acceptance system," which is described at length in paragraphs [0222] to [0244], has no sorting capability of the kind recited in the claim. Therefore, it is not the case that Stoutenburg identically teaches the sorting step.

In the Advisory Action the Examiner had another chance to identify a passage that expressly shows these sub-files, but the Examiner fails to identify any such passage. Indeed, the Examiner tacitly admits that no such express support exists in Stoutenburg because the Examiner tries to show anticipation by another way. Instead of just showing a passage that expressly teaches these sub-files, the Examiner bases the anticipation argument only on an "interpretation" of the automatic check information routing feature of Stoutenburg, a feature, by the way, that is never characterized by Stoutenburg as explicitly involving the two sub-files of the claimed invention. The "interpretation" appears to be an argument based on inherency: even though Stoutenburg fails to expressly teach the recited sub-files, they are inherent to the check routing of Stoutenburg, or so the Examiner appears to argue.

In order to show that a feature that is not expressly taught by a reference is nevertheless inherent to that reference, the Patent Office has the burden of demonstrating that the unexpressed feature must be necessarily present in the reference. For example, if a reference teaches the use of copper for some purpose, an Examiner could assert that the references shows an electrically conductive material, even though the reference says nothing about the electrical properties of copper. On the other hand, a feature that might be present or would be desirable for it to be present, given a particular teaching in the prior art, is not inherent to the prior art because it falls short of the standard of necessity. For instance, a reference that teaches the use of a screw cannot be said to inherently teach that the screw is metal. It could just as well be made of wood or plastic.

In Stoutenburg, the teaching of check routing does not necessarily entail that only consumer checks are placed in one sub-file and only non-consumer checks in another subfile. Check routing can cover many possible ways of organizing checks that do not involve dividing the consumer checks from the non-consumer checks. In the Advisory Action, the Examiner

points to paragraphs [0187] and [0078]. Paragraph [0187] reads as follows:

> In particular embodiments of the present invention, POS device 130 automatically routes check information to the proper function central control 110. This can be done based on the routing numbers or other information provided on a presented check. Thus, as the check information is entered into POS device 130, POS device 130 automatically determines the associated function central control 110, and initiates communication with the selected function central control 110. If a function central control cannot be identified for the presented check, POS device 130 can present an error message via display 210 and/or display 252. In such a case, the transaction can be denied and the check returned to the customer.

Paragraph [0078] reads as follows:

> In some embodiments, a Magnetic Ink Character Recognition ("MICR") reader is integrated with POS device 130 and accessible via MICR interface 234. Such a MICR reader facilitates reading magnetically printed account information from both business and personal documents including, but not limited to checks. Such a MICR reader provides POS device 130 with the ability to read the MICR line in either direction, under control of software operating on CPU 218. In particular embodiments, the MICR reader is motorized and automatically recognizes and reads E13B and CMC7 code line formats. Both business and personal checks can be processed, up to checks three and eight-tenths inches by eight and three-quarters inches. The MICR reader can read checks both magnetically and optically using information derived from the document imager as further described below. In some embodiments, software running on CPU 218 controls all access of the merchant to the MICR received via the touch-screen display and/or the keyboard. Logic associated with MICR interface 234 is capable of extracting the various fields on the MICR line. Such logic can be implemented in either hardware or software with the parsing algorithms associated therewith that can be updated by modifying either the software after manufacture and installation of POS device 130.

The first passage has nothing to do with the sub-files of the claimed invention. In this passage, information is read from a check, and that information is used to identify a particular function central control. As explained above, the function central controls involve fraud detection, phone card system, check acceptance system, and a money transfer system. None of these function central controls have anything to do with dividing consumer checks from non-consumer checks in the manner recited in the claim. Similarly, the second passage does not provide any basis for concluding that this type of dividing operation is necessarily present in

Stoutenburg. The second passage describes the POS device 130 as having the ability to read MICR information printed on consumer and business checks. Nevertheless, to conclude that the division of checks into a business only sub-file and a consumer only sub-file is inherent to or necessarily follows from the ability, generally speaking, to process business and personal checks is to engage in a non-sequitur. It is not true that the check division feature of the claim necessarily follows from the ability to read MICR information from business and consumer checks. The inherency argument that the Examiner appears to be proffering could work only if the only possible use of MICR information was to segregate consumer and non-consumer checks from each other. This obviously is untrue, since MICR information has a far greater versatility than this, as evidenced by the various uses to which it is put in Stoutenburg. If the processing of MICR information is used for functions unrelated to the recited check segregation, then the recited check segregation is not inherent to the processing of MICR information.

CONCLUSION

For the reasons set forth above, Applicants respectfully request that the final rejections of claims 1 - 21 be reversed and that these claims be allowed.

Respectfully submitted,

Dated: October 20, 2008

By: _____
Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel: (212) 619-6000
Fax: (212) 619-0276